UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,554	03/31/2004	Richard Warren Hailey	014586-9015-00	7426

1131   7590   03/20/2008
MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

EXAMINER
RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
03/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/814,554	HAILEY ET AL.
	Examiner	Art Unit	
	AMELIA RUTLEDGE	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-30,34-46 and 52* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *25-30,34-46 and 52* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/23/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to: Amendment, filed 01/14/2008; Request for

Continued Examination, filed 01/14/2008; Information Disclosure Statement, filed

01/23/2008.

2.   Claims 25-30, 34-46, and 52 are pending in the case. Claims 25, 34, and 52 are

independent claims.

3.   Claims 25, 34, and 52 have been amended to overcome the previous claim

rejections under 35 U.S.C. 101, therefore the previous rejections of claims 25-30, 34-46,

and 52 for being directed to non-statutory subject matter under 101 have been

withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

01/14/2008 has been entered.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 34-46, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Mohr et al. ("Mohr"), U.S. Patent No. 6,826,727 B1, issued November 2004.**

Regarding independent claim 34, Mohr teaches a computer readable medium having computer executable instructions for generating instances of a document based on a template defining a data structure for the document, since Mohr teaches a system for laying out documents with flexible layout process and variable data publishing system (col. 2, l. 40-col. 6, l. 38; Abstract).   Mohr teaches that the template schema comprises a template root element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); a template information element (col. 13, l. 22-67); a data table element (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38), since Mohr teaches content mapping rules to map variable data from a database table (col. 13, l. 2-6), i.e., a data table element.

Mohr teaches that the template schema comprises an instances element including at least one instance element configured to describe how a document is constructed (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67; col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50). Mohr teaches content mapping rules to map variable data from different template files,

and a given template file can be used with content mapping rule sets of different

projects (col. 38, l. 47-col. 39, l. 60).

Mohr teaches that the instance element includes an instance data table element

and at least one continuations element, the continuations element defining continuation

handling for data included in the data table element, the instance data table element, or

both, because Mohr teaches different content mapping rules for different projects and

elements within the projects, in order to create variable page elements for each project

(col. 38, l. 47-col. 40, l. 53; col. 42, l. 37-col. 43, l. 37).

Regarding dependent claim 35, Mohr teaches that the template information

element includes descriptive information about the template element (col. 13, l. 22-67).

Regarding dependent claim 36, Mohr teaches that the descriptive information

includes a title element that contains a title for the document at hand (Fig. 50, items

130C, 130D, and 130E), a description element that is a container for free-form text

about the template element (col. 13, l. 6-38), a help text element, which is a container

for free-form information that may be useful to a consumer of the document (col. 13, l.

6-38), and Mohr implies a document type element that is provided to support a type

element from other schemas or DTDs (col. 12, l. 65-col. 13, l. 38), since Mohr teaches

using content mapping rules, the association of outside files, and mapping element

content to a digital asset management system.

Regarding dependent claim 37, Mohr teaches that the template information

element includes a print constraints element which is a container for special values

that may be needed or used by a printing environment (col. 41, l. 3-55).

Regarding dependent claim 38, Mohr teaches that the data table element

includes data values to be used in a specific instance of a template, (col. 14, l. 29-45;

col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically

mapping files into a template container that is a variable element (col. 13, l. 39-67).

Regarding dependent claim 39, Mohr teaches that the data table element

defines a structure of data values that can be accessed by name, or by a combination of

name and one or more indices (col. 12, l. 17-col. 13, l. 37).

Regarding dependent claim 40, Mohr teaches that the instances element is

configured to include one or more instance elements, which is implied by the disclosure

of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-

col. 13, l. 38).

Regarding dependent claim 41, Mohr teaches that the instance element is

configurable to include an instance data table element (col. 38, l. 47-col. 39, l. 60), a

pages element (col. 11, l. 43-59), an overlays element, i.e., layout box element (col. 11,

l. 26-42), a continuations element, i.e., element for designating size and positioning (col.

42, l. 37-col. 43, l. 37; col. 11, l. 20-59; col. 14, l. 29-45), and a data element (col. 13, l.

6-38).

Regarding dependent claims 42 and 43, Mohr teaches that the pages element

is configurable to include a page element and the page element is configurable to

include an overlays element and a composition element (col. 14, l. 59-col. 15, l. 12),

since Mohr teaches that certain template elements can be mapped to variable

elements, and Mohr teaches mapping variable text elements (col. 11, l. 42-col. 12, l.

24), the nesting of elements to include other elements, and mapping of content into box

elements and shape elements (col. 13, l. 6-21; col. 14, l. 29-45).

Regarding dependent claim 44, Mohr teaches that the overlays element is

configurable to include one or more overlay elements, which is implied by the disclosure

of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-

col. 13, l. 38).

Regarding dependent claim 45, Mohr teaches that the continuations element is

configurable to include one or more continuation elements and one or more overflow

default elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26)

and the mapping of variable values (col. 12, l. 16-col. 13, l. 38; col. 25, l. 8-24).

Regarding dependent claim 46, Mohr teaches that continuation elements are

configured to be used by a processor to process overflows (col. 42, l. 36-col. 43, l. 63).

Regarding independent claim 52, Mohr teaches a computer readable medium

having computer executable instructions for generating instances of a document based

on a template structured according to a schema, since Mohr teaches a system for laying

out documents with flexible layout process and variable data publishing system (col. 2, l.

40-col. 6, l. 38; Abstract).

Mohr teaches that the schema comprises a data table element configured to

contain data that is used to transform an abstract instance of a document template to a

concrete instance of a document template (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l.

38; Figs. 49, 50), since Mohr teaches content mapping rules to map variable data from

different template files, and a given template file can be used with content mapping rule

sets of different projects (col. 38, l. 47-col. 39, l. 60).

Mohr teaches that the template has an instances element containing at least one

instance element, because Mohr teaches different content mapping rules for different

projects and elements within the projects, in order to create variable page elements for

each project (col. 38, l. 47-col. 40, l. 53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mohr in view of Shiigi et al. ("Shiigi"), U.S. Pub. No. 2003/0014442 A1,

published January 2003, filed July 2002.

Regarding independent claim 25, Mohr teaches a computer readable medium

having computer executable instructions for generating instances of a document based

on a template structured according to a schema, since Mohr teaches a system for laying

out documents with flexible layout process and variable data publishing system (col. 2, l.

40-col. 6, l. 38; Abstract). Mohr teaches that the schema comprises a template root

element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); and a template information

element (col. 13, l. 22-67).

Mohr teaches a data table element configured to contain data that is used to transform an abstract instance of a document template to a concrete instance of a document template (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50), since Mohr teaches content mapping rules to map variable data between a database and different template files, and a given template file can be used with content mapping rule sets of different projects (col. 38, l. 47-col. 39, l. 60). Mohr also teaches mapping content from a data table element of content mapping rules (col. 39, l. 15-51; col. 40, l. 5-col. 41, l. 30).

While Mohr does teach tracking template instances (col. 39, l. 15-38) Mohr does not explicitly teach that the data table element is used to determine the number of instances of a document template, however, Shiigi also teaches transforming an abstract instance of a document template to a concrete instance of a document template (p. 2, par. 0016-0017), because Shiigi teaches a method of creating and modifying a template hierarchy. Shiigi is relied upon to disclose determining the number of instances of a document template, because Shiigi teaches the use of an object model, where a single table in the database holds all file records in the file system, and where each file has a unique file ID, including the templates (p. 6, par. 0088-p. 7, par. 0090). Because Shiigi teaches a method of defining a template hierarchy (p. 10, par. 0119), and storing and recording each file in a database table where each file has a unique ID, Shiigi teaches a data table linked to an object model which can be used to determine the number of instances of a document template.

Mohr teaches that the schema comprises an instances element containing at least one instance element (col. 38, l. 47-col. 39, l. 60), which describes how each individual instance of the document is constructed (col. 14, l. 29-45; col. 11, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67; col. 42, l. 37-col. 43, l. 37).

Both Mohr and Shiigi are directed toward creating and managing document templates. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the template hierarchy and database disclosed by Shiigi with the template content mapping system and database disclosed by Mohr, since both systems had many of the same components, including linked templates and a database table, and it would have been both obvious and desirable to track the files in the database table with unique IDs as disclosed by Shiigi, thereby providing a framework for developing documents using template inheritance that was more robust and simpler to manage than the traditional file directory model of conventional web applications (Shiigi, p. 2, par. 0021).

Regarding dependent claim 26, Mohr teaches that the instance element is configurable to include an instance data table element (col. 38, l. 47-col. 39, l. 60), a pages element (col. 11, l. 43-59), an overlays element, i.e., layout box element (col. 11, l. 26-42), a continuations element, i.e., element for designating size and positioning (col. 42, l. 37-col. 43, l. 37; col. 11, l. 20-59; col. 14, l. 29-45), and a data element (col. 13, l. 6-38).

Regarding dependent claim 27, Mohr teaches that the pages element is configurable to include a page element and the page element is configurable to include an overlays element and a composition element (col. 14, l. 59-col. 15, l. 12), since Mohr teaches that certain template elements can be mapped to variable elements, and Mohr teaches mapping variable text elements (col. 11, l. 42-col. 12, l. 24), the nesting of elements to include other elements, and mapping of content into box elements and shape elements (col. 13, l. 6-21; col. 14, l. 29-45).

Regarding dependent claim 28, Mohr teaches that the overlays element is configurable to include one or more overlay elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38).

Regarding dependent claim 29, Mohr teaches that the continuations element is configurable to include one or more continuation elements and one or more overflow default elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38; col. 25, l. 8-24).

Regarding dependent claim 30, Mohr teaches that the instance data table element is configurable to include one or more datum elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38).

Response to Arguments

1.   In response to applicant's arguments regarding the claim rejections under 35

U.S.C. 101 (Remarks, p. 6 and 9-10), claims 25, 34, and 52 have been amended by

applicant to overcome the previous claim rejections under 35 U.S.C. 101, therefore the

previous rejections of claims 25-30, 34-46, and 52 for being directed to non-statutory

subject matter under 101 have been withdrawn.

2.   Applicant's arguments filed 01/14/2008 have been fully considered but they are

not persuasive.

In response to applicant's arguments regarding the rejections of independent

claim 25 (Remarks, p. 7-9), Mohr does teach that the schema comprises a data table

element configured to contain data that is used to transform an abstract instance of a

document template to a concrete instance of a document template (col. 11, l. 60-col. 24;

col. 12, l. 65-col. 13, l. 38; Figs. 49, 50), since Mohr teaches content mapping rules to

map variable data from different template files, and a given template file can be used

with content mapping rule sets of different projects (col. 38, l. 47-col. 39, l. 60).

Further, a new ground of rejection, the Shiigi publication, is now being relied upon to

teach the newly claimed limitation of independent claim 25, ...*and to determine the*

number of instances of a document template.

Regarding the arguments for dependent claim 26 (Remarks, p. 9-10), in

response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., the

specific interpretation of "continuations element" in the specification) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is further noted that, Mohr does teach

a continuations element at col. 42, l. 37-col. 43, l. 37 since Mohr teaches handling text

layout flow under different arrangements.

Applicant's remaining arguments regarding the rejections of claim 25 (Remarks,

p. 10-11), rely on an analysis of the XML code in Fig. 4 of Mohr, which was not cited in

the claim rejection of claim 25. It is respectfully noted that the Mohr patent includes 64

figures, at least 20 of which list computer code. Therefore applicant's analysis of the

XML code in Fig. 4 of Mohr is incomplete in that it does not take into account the

portions of Mohr cited in the rejection of claim 25, nor the other listings of computer

code disclosed by Mohr.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Novik et al.   U.S. Patent No. 7,100,167 B2   issued   August 2006

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to AMELIA RUTLEDGE whose telephone number is

(571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

/Amelia Rutledge/
Examiner, Art Unit 2176